



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,619	02/20/2004	Ming Chiu Fung	14761US02	7207
40614	7590	12/20/2007		
WILKINSON & GRIST 6TH FLOOR, PRINCE'S BUILDING CHATER ROAD, CENTRAL HONG KONG, CHINA			EXAMINER MI, QIUWEN	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 12/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,619	Applicant(s) FUNG ET AL.	
	Examiner Qiuwen Mi	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-77, 80-91 and 94-100 is/are pending in the application.
- 4a) Of the above claim(s) 83-86 and 97-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 72-77, 80-82, 87-91 and 94-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment in the reply filed on 11/26/07 is acknowledged. Any rejection that is not reiterated is hereby withdrawn.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/26/2007 has been entered.

Claims Pending

Claims 72-77, 80-91, and 94-100 are pending. Claims 1-71, 78-79, and 92-93 are cancelled. Claims 83-86, and 97-100 are withdrawn. Claims 72-77, 80-82, 87-91, and 94-96 are examined on the merits.

Specification/Abstract Objections

Specification

The disclosure is objected to because of the following informalities: The specification recites "novel" on pages 1, 6, and 12. It is suggested that the term "novel" be deleted from the language of the specification. Once the determination of the novelty of a claimed invention has been established and the disclosure of the invention made public and/or

patented, the claimed invention is no longer novel or new, since the scope of the invention no longer embraces what is considered "novel". Thus, the incorporation of the term "novel" into the language of the specification is not appropriate. Correction is required.

Claim Rejections –35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 72-77, 80-82, 87-91, and 94-96 are rejected under 35 USC § 102 (a) as being anticipated by Ozaki et al (Biological & pharmaceutical bulletin, (1996 Aug) Vol. 19, No. 8, pp. 1046-8).

Ozaki et al teach the cut dried fruit of *T. Kirilowii* was refluxed (thus heated at boiling temperature 78 °C) with 50% ethanol solution (thus contacting plant with solvent to form a mixture) three times for 6 h each time. The solutions were filtered through gauze and then freeze-dried to give powdered extract (page 1046, 1st column, 4th paragraph). Ozaki et al also teach that the extract has anti-inflammatory effect.

These are product-by-process claims. The 50% ethanol solution extract of *T. Kirilowii* inherently contains the pharmaceutical composition that is being currently claimed, and the composition is deemed to have the physical properties such as retention time on high performance liquid chromatography.

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that it is deemed that the prior art product must not be precluded for use to induce hemoglobin synthesis in human K562 cells, especially in the absence of sufficient, clear, and convincing evidence to the contrary. It is deemed that the composition disclosed by Ozaki et al. is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/783,619
Art Unit: 1655

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi


MICHELE FLOOD
PRIMARY EXAMINER